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IV. REMARKS

Applicants respectfully request consideration of the following remarks and entry of the above amendments prior to examination of this application on the merits.

1. Summary of the Amendments

Claims 1-12, 15 and 18-19 have been canceled without prejudice or disclaimer. Claims 22 and 23 have been added. Accordingly, upon entry of the above amendments, Claims 13, 14, 16, 17 and 20-23 will be pending for examination on the merits.

Claim 13 has been rewritten in independent form and amended to delete -S-S- from the values for W. Support for Claim 13 as amended is found, for example, in on page 12, line 26 to page 14, line 06; and in Claims 11 and 13 as originally filed.

Support for newly added Claim 22 is found, for example, on page 9, line 19; and in Claim 14 as originally filed.

Support for newly added Claim 23 is found, for example, on page 14, line 01; and in Claim 14 as originally filed.

In the above amendments, Applicant has focused the claimed subject matter on glycopeptides of formula II in which W is -S-C(=O)-. The present amendments are not being made in response to any cited prior art or to meet any other cited requirements for patentability. Applicant reserves the right to pursue other aspects of this invention in subsequently filed applications. Entry of these amendments is respectfully requested.

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2. Restriction Requirement Under 35 U.S.C. §121

The Examiner has indicated that restriction to one of the following inventions is required under 35 U.S.S. §121:

- Group I Claims 1-17, drawn to a glycopeptide compound having at least one substituent of the formula $-R^a-Y-R^b-(Z)_x$, and a pharmaceutical composition comprising the glycopeptide, classified in class 530, subclass 322.
- Group II Claim 18-21, drawn to a method of treating a mammal having a bacterial disease comprising administering a glycopeptide compound having at least one substituent of the formula $-R^a-Y-R^b-(Z)_x$, classified in class 530, subclass 322.

In response, Applicant hereby elects Group I with traverse. Of the now pending claims, Claims 13, 14, 16, 17, 22 and 23 are believed to be within Group I; and Claims 20 and 21 are within Group II. For the following reasons, Applicant respectfully traverses the requirement for restriction of these groups.

The Examiner is required to conduct a search and examination of the entire application even though it includes claims to independent or distinct inventions, if the search and examination can be made without serious burden. See MPEP §803. In the present case, the Examiner has not indicated in any way why a search of the entire application would create a serious burden. In fact, since the compounds of this invention are antibiotics, any search for the compounds would by necessity also produce prior art relating to the use of the compounds as antibiotics. This is evidenced by the fact that the claims of Groups I and II are classified in the same classes and subclasses (i.e., class 530, subclass 322). Thus, the Examiner would not be required to search any additional classes or subclasses in order to search Group II along with Group I. Accordingly, a search and examination of the entire application can be made without serious burden and therefore, the Examiner is required to conduct such a search and examination of the entire application.

Accordingly, Applicant respectfully requests that the Examiner withdraw the

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restriction for requirement imposed on the pending claims under 35 U.S.C. §121.

3. Additional Election Under 35 U.S.C. §121

The Examiner has also indicated that:

Should Invention I or II be elected, applicant is required to select one formula of a glycopeptide from formula (I) or (II) with each variable defined in the formula. Each glycopeptide compound with different amino acid sequence and different functional group, absent factual data to the contrary, is a distinct compound. This is not a species election. (Office Action at page 2).

In response, Applicant elects, with traverse, the following: Formula II, where R^a is alkylene and R^h is alkyl. For the following reasons, Applicant respectfully traverses this further requirement for restriction under 35 U.S.C. §121.

The Examiner's requirement that the invention be restricted to each distinct compound is improper and contrary to the rules, statutes and case law governing restriction practice. In particular, the Examiner's has given no specific reasons why this further restriction requirement is necessary other than to indicate each compound is "a distinct compound." Being a distinct compound is not the basis for restriction under any the present rules and statutes that govern restriction practice. In this regard, the Examiner's attention is respectfully directed to the tens of thousand of chemical patents that issue each year containing more than one "distinct compound".

In actuality, the groups the Examiner wishes to restrict are merely members of the Markush groups defining the subject matter that Applicant regards as her invention. In such situations, the case law is very clear -- the Examiner is required to examine all members of the Markush groups unless the subject matter lacks unity of invention. *In re Weber*, 580 F.2d 455, 198, USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978). See also MPEP §803.02.

In the present case, the Examiner has not made any showing whatsoever that the claimed subject matter lacks unity of invention. In fact, as noted above, the Examiner has given no specific reasons for requiring this further restriction other than indicating that each compound is a "distinct compound." Moreover, even if the Examiner were to show that the

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claimed subject matter lacked unity of invention, the proper action would be an election of species not a further restriction requirement. See MPEP §803.02

Accordingly, Applicant respectfully requests that this further restriction requirement be withdrawn. Alternatively, if this further restriction requirement is maintained, Applicant respectfully requests that, before making this requirement final, the Examiner make a proper showing of the necessity for the further restriction requirement under the proper rules and statutes so that Applicant has an opportunity to properly and fully respond.

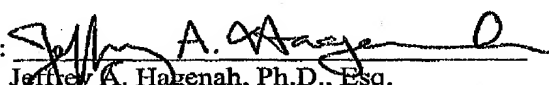
Examination of this application on the merits is respectfully requested. Should there be any issues regarding this application that can be resolved by telephone, the Examiner is respectfully requested to telephone the undersigned attorney at (650) 808-6406.

Respectfully submitted,

THERAVANCE, INC.

Date: October 7, 2003

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